

## REMARKS

The precedent amendments and following remarks are submitted in response to the final Office Action mailed June 5, 2006, setting a three-month shortened statutory period for response ending September 5, 2006. Currently, claims 21-35 are pending in the Application. Reconsideration, examination and allowance of all pending claims are respectfully requested.

### 35 U.S.C. § 103 Rejections

On page 2 of the Office Action, the Examiner rejected claims 21, 22, and 24-31 under 35 U.S.C. § 103 as being unpatentable over *Engelson et al.* (U.S. Patent No. 5,972,019). The Examiner, while acknowledging that the *Engelson et al.* reference does not disclose a cage assembly including a proximal cage and a distal cage, nevertheless maintains that it would have been obvious to construct the device in *Engelson et al.* having both a proximal and distal cage “since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.” Office Action at p. 4 (citing *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8 (7<sup>th</sup> Cir. 1977)).

On page 4 of the Office Action, the Examiner rejected claims 21-31 under 35 U.S.C. § 103(a) as being unpatentable over *Schmaltz et al.* (U.S. Patent No. 5,449,372) in view of *Crittenden et al.* (U.S. Patent No. 4,719,924). Again, while acknowledging that neither reference discloses a cage assembly including both a proximal and distal cage, the Examiner nevertheless asserts that it would have been obvious to provide a proximal and distal cage “since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.” Office Action at p. 6 (citing *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8 (7<sup>th</sup> Cir. 1977)).

Applicants respectfully traverse the Examiner's obviousness rejections of claims 21-31. As discussed previously in Applicants' prior Amendment filed on March 2, 2006, the decision in *St. Regis Paper Co. v. Bemis Co.* does not provide support for the Examiner's position that the inclusion of both a proximal cage and a distal cage would have been obvious as being a mere duplication of essential working parts involving only routine skill in the art. In *St. Regis Paper*, the Court addressed the situation where the duplicative feature (*i.e.* the use of multiple bag layers) had already been known in art, and where each element performed the same function it performed in the prior art. In this situation, the court stated that the arrangement of old elements in new combinations does not satisfy § 103 unless the combination produces a synergistic effect. *See St. Regis Paper*, 193 USPQ at 11.

Although the decision in *St. Regis Paper v. Bemis Co.* provides guidance in those cases where the duplicative feature was already known in the art, and where the duplicative features performed the same function, Applicants assert that the *St. Regis Paper* decision is not controlling in the present case. Unlike the prior art at issue in *St. Regis Paper*, the patents cited by the Examiner in the present case do not appear to teach an embolism treatment device including a cage assembly having a proximal cage and distal cage, as recited in each of the claims. Thus, in contrast to the situation in *St. Regis Paper* where the alleged duplicative feature was already known in the prior art, the proximal and distal cage assembly set forth in the current claims are not known from the cited prior art. Therefore, *St. Regis Paper* is distinguishable from the present case.

Furthermore, the inclusion of a proximal cage and a distal cage may provide more than just a duplication of function, providing a synergistic effect. In some embodiments,

for example, the proximal and distal cages may each serve different purposes, which, when taken together, can be used to provide an entirely different result or function. For example, as set forth on page 9, lines 10-21 of the Application, the proximal cage may provide rapid restoration of fluid flow through and/or remove an occlusion from a lumen whereas the distal cage may be used to capture dislodged embolic debris. Therefore, since the proximal and distal cages may serve different purposes providing a synergistic effect, Applicants assert that these elements are not just a mere duplication of parts involving only routine skill in the art, as suggested by the Examiner. Accordingly, Applicants assert that claims 21-31 are not obvious under 35 U.S.C. § 103.

In addition to incorrectly applying the *St. Regis Paper* case to support the obviousness rejection of claims 21-31, the Examiner further appears to suggest in error that Applicants must establish that the proximal and distal cage limitations are “critical” in order to overcome the Examiner’s arguments. On pages 6-7 of the Office Action, for example, the Examiner states:

Applicant’s arguments filed March 2, 2006 have been fully considered but they are not persuasive. Applicant’s arguments with regard to claims 21-31 do not overcome the rejections applied thereto, since applicant has not provided any convincing showing that these are nothing more than duplication of parts as asserted by the examiner. **Applicant has not provided any showing that such limitations are “critical”.** In re Cole, 140 USPQ 230 (CCPA 1964); In re Kuhle, 188 USPQ 7 (CCPA 1975); In re Davies, 177 USPQ 381 (CCPA 1973). Mere arguments by counsel cannot take the place of evidence. In re Cole, 236 F.2d 769, 773, 140 USPQ 230, 233 (CCPA 1964); In re Walters, 168 f.2d 79,80, 77 USPQ 609,610 (CCPA 1948; et al..

(emphasis added).

Applicants have carefully reviewed the *In re Cole*, *In re Kuhle*, and *In re Davies* decisions cited by the Examiner (see above), and assert that these cases do not require a showing that the limitations regarding the proximal and distal cages be “critical”, as asserted by the Examiner. The only decision which appears directed to whether recited limitations are “critical” is the *In re Cole* decision, which discusses the criticality of claim limitations involving proportions or concentrations in composition of matter or process claims. Nothing in any of these cases discusses “critical” claim limitations where duplicative features are alleged to be obvious. Accordingly, Applicants assert that the Examiner’s statement that there must be a showing that such claim limitations are “critical” is incorrect.

On page 6 of the Office Action, the Examiner rejected claims 32-35 under 35 U.S.C. § 103(a) as being unpatentable over *Engelson et al.* (U.S. Patent No. 5,972,019) in view of *Lefebvre* (U.S. Patent No. 5,421,832).

For at least the reasons discussed above, Applicants assert that claims 32-35 are not obvious in view of the *Engelson et al.* and *Lefebvre* references. As discussed previously, the *Engelson et al.* reference fails to disclose or suggest a cage assembly including a proximal cage and a distal cage, as recited in independent claim 26. The *Lefebvre* reference similarly fails to disclose or suggest this feature. Thus, since claims 32-35 depend from claim 26, and since these claims contain other significant elements, Applicants assert that claims 32-35 are in condition for allowance.

Reexamination and reconsideration are respectfully requested. It is submitted that all pending claims are currently in condition for allowance. Issuance of a Notice of

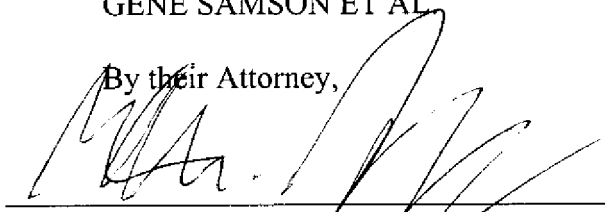
Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at 612.677.9050.

Respectfully submitted,

GENE SAMSON ET AL

By their Attorney,

Date: Aug 7, 2006

  
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